

## **IV. REMARKS**

### **A. Office Action - Detailed Action**

#### ***1. Claim Rejections under 35 USC § 102(b)***

Claims 10 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by Gehrke et al. (US 6,039,914).

In response to this rejection, and as discussed further below, claims 4 and 10 have been amended to distinguish over Gehrke et al.

#### ***2. Claim Rejections under 35 USC § 102(e)***

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by Petermeier (U.S. 6,497,930).

#### ***3. Claim Rejections under 35 USC § 103(a)***

Claims 4-9 and 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gehrke in combination with Petermeier.

### **B. Amendments to the Claims**

Pursuant to the current amendment practice, a complete listing all claims presented in the application is provided above, with current claim status, and the text of all claims currently under examination. Changes to currently amended claims are indicated with revision markings to show the changes as revised from the immediately prior version thereof. The revisions are shown with underlining for added material, strikethrough for deleted material, and double brackets [[ ]] (as appropriate) to show deletion of five characters or fewer and deleted material that cannot be easily perceived with a strikethrough.

The only amendment to the claims is a correction of a typographical error in claim 10, the word "provided" is changed to --provide--.

### **C. Amendments to the Drawings**

Pursuant to the current amendment practice, drawing changes are made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84.

Replacement Drawing Sheets 1-5 are included with replacement FIGS. 1-13. The purpose of the Replacement Drawing Sheets is to present formal drawings into the application. The replacement figures on the Replacement Drawing Sheets are not materially different than the informal figures and drawing sheets currently pending in the application. Accordingly, no markups or further explanation of the changes to the drawings is believed to be required.

### **d. Request for Reconsideration**

Applicant respectfully requests reconsideration of the rejection of claims 1-3 for the following reasons.

As previously noted, claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by Petermeier (U.S. 6,497,930). However, Petermeier is not a proper reference against the present application under 102(e).

#### **35 U.S.C. § 102(e) reads (as presented in the Office Action):**

A person shall be entitled to a patent unless -

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

#### **MPEP § 706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or**

#### **Patent reads (in pertinent part):**

A rejection based on 35 U.S.C. 102(e) can be overcome by:

(F) Perfecting priority under 35 U.S.C. 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a).

**MPEP § 2136.05 Overcoming a Rejection Under 35 U.S.C. 102(e)** reads (in pertinent part):

... The filing date can also be antedated by applicant's earlier foreign priority application or provisional application if 35 U.S.C. 119 is met and the foreign application or provisional application "supports" (conforms to 35 U.S.C. 112, first paragraph, requirements) all the claims of the U.S. application. ...

The present application was filed on April 18, 2001, with a perfected priority claim under 35 U.S.C. § 119(e) in the first line of the specification that reads:

Cross-references to related applications: - This application claims priority to U.S. Provisional Patent Application S/N 60/198,463, filed April 18, 2000.

The identical priority claim was continued in the Substitute Specification filed in the application. And the provisional application supports all of the claims of the present application.

Petermeier was filed on April 11, 2001, and it does not claim priority to any earlier filed application. The priority date April 18, 2000 of the present application well precedes the filing date of the Petermeier application. Therefore, Petermeier is not a proper 102(e) reference, and claims 1-3 are not properly rejected.

Applicant further requests reconsideration of the rejection of claims 4-9 for the following reasons.

As previously noted, claims 4-9 and 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gehrke in combination with Petermeier.

The basis for the rejection includes that "Petermeier teaches higher temperatures can be used and are within the range taught by applicant thus providing a suggestion or motivation to one having ordinary skill in the art the time was made to adjust or modify the temperature range which provides best results for compaction or shaping or molding or extruding thus rendering applicant's claims as a whole obvious."

However, for the reasons stated above, Petermeier is not a proper 102 reference.

Therefore, Petermeier cannot provide foundation for an obviousness rejection under 103, and claims 4-9 and 11-16 are not properly rejected. (See MPEP § 2141.01 (I)).

Applicant further requests reconsideration of the rejection of claims 10 and 17-18 for the following reasons.

As previously noted, claims 10 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by Gehrke et al. (US 6,039,914). The rejection was made for the reasons of record in the previous office action (paper No. 4, paragraph 6). The relevant paragraph of that previous office action reads:

Gehrke et al. teach using recycled asphalt shingles to produce a fine aggregate-asphalt mixture. The recycled shingles are ground in a hammer mill[ Note Column 6, lines 64-65], then extruded and cut to produce a shaped part. Gehrke et al. teaches that the asphalt shingles contain a coating of fine minerals, which would meet applicant's mixture of fine aggregate and asphalt mixture. [Note Column 5, lines 43-49]. The extrusion apparatus is found in Column 10, lines 49-53. The cutting apparatus for producing the shaped part after extrusion is found in Column II, lines 50-67 and Column 12, line 1-4. The apparatus as described by Gehrke et al. specifically provides material inlet to receive shingle material, a grinder and extruder having an inlet to receive the ground material from the grinder and a die cutter or cutting station and the extrusion molding station associating with the extruder for receiving the extrudate material to produce a shaped product therefrom.

In response to the rejection in that office action, claim 10 was amended to read, in pertinent part (with addition underlined):

a grinder having an inlet to receive shingle material from the staging station and having an outlet to discharge ground shingle material, the grinding further having a heating element for raising the temperature of the shingle material therein prior to discharge of the material;

As indicated in applicants response to the previous office action, and as shown above, claim 10 was amended to specify the grinder having a heating element for raising the temperature of the shingle material. Gehrke et al does not teach or suggest this aspect of the present

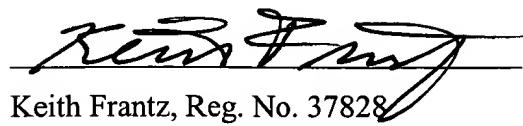
invention, nor is this aspect suggested in the prior art or obvious in view thereof. Therefore, applicant believes that previously amended claim 10 patentably distinguishes over Gehrke et al..

The current rejection of claim 10 in the current Office Action does not address or even consider applicant's previous amendment to claim 10. The current Office Action does not even recognize that applicant did amend claim 10 in the manner identified in response to the previous office action. Therefore, applicant respectfully requests reconsideration of the current rejection of claim 10 in view of the previous amendment thereof.

In addition to the above-noted reasons supporting reconsideration of the rejection of the claims under examination in this application, rejection of the claims is further not proper or properly supported in the current Office Action. Among other things, and as non-exhaustive examples, the prior art does not anticipate or suggests - introduction of a granular surface treatment as specified in claims 2, 13 and 14; - introduction of a plastic liner as specified in claim 3; - controlling the ratio of aggregate to asphalt as specified in claims 4, 12 and 15, or addition of aggregate related thereto as recited in claim 16; - the softening and embedding steps recited in claim 5, and the additional elements related thereto recited in claims 6-9; - the preheater as recited in claim 17, and - the material conveyer to convey the extruded material from the extruder to the next station.

For all of the above reasons, applicant believes all of the claims currently under examination in the application are allowable over the prior art, and respectfully requests reconsideration and withdrawal of the rejections of these claims.

Respectfully submitted,



A handwritten signature in black ink, appearing to read "Keith Frantz". The signature is written in a cursive style with a horizontal line underneath it.

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